

Application No. 10/025,037

REMARKS

Claims 1-25 are pending. By this amendment, claims 1, 7, 15 and 19 are amended. No new matter has been added by these amendments.

Interview Summary

An Examiner's Interview was conducted on August 24, 2004, in which the Examiner and Applicant's attorney discussed U.S. Patent No. 3,745,023 to Greenberg et al. As discussed, Greenberg et al. is directed to a pet food supplement. Applicant has amended independent claim 1 as discussed to include an ingestible substance. Support for this amendment can be found in the specification as originally filed at Page 4, Line 14 – Page 7, Line 22.

Claim Objections

The Examiner objected to claim 15 as containing a typographical error. Applicant, by this amendment, has corrected this error. Applicant respectfully requests said objection be withdrawn.

Claim Rejections – 35 USC § 112

The Examiner rejected claims 19-25 under 35 USC § 112, second paragraph, as being indefinite for failing to point out and distinctly claim the subject matter which Applicant regards as the invention. Applicant has amended independent claim 19 to further clarify the claims as being directed to a method for preparing an ingestible, viscous dietary supplement. Applicant respectfully requests the rejections to claims 19-25 be withdrawn.

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Claim Rejections – 35 USC § 102

The Examiner rejected claims 1, 2 and 6 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 3,745,023 to Greenberg et al. Applicant has amended independent claim 1 as discussed during the interview of August 24, 2004. As amended, independent claim 1 describes a viscous carrier protecting an ingestible substance from degradation caused by assorted environmental factors. As such, Applicant respectfully requests the Examiner withdraw this rejection as agreed during the Interview. For the same reasons, Applicant respectfully requests the Examiner withdraw the rejection to dependent claims 2 and 6.

The Examiner rejected claims 1-3, 6-9, 12 and 13 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,913,921 to Schroeder et al. Applicant has amended independent claims 1 and 7 to further define the present invention as describing a viscous carrier protecting an ingestible substance from degradation caused by assorted environmental factors. Applicant respectfully asserts that Schroeder et al. does not disclose a viscous carrier protecting an ingestible substance from degradation by environmental factors. Instead, Schroeder et al. describes the use of flavor-stabilized fish oils (stabilized by the essential element fructose) used in the production of food products. Applicant respectfully asserts that Schroeder et al. fails to suggest or disclose a viscous carrier as offering any form of protection to an ingestible substance.

In considering composition ranges disclosed by prior art, a case by case determination of anticipation is necessary when the prior art overlaps a claimed range but no specific examples within the claimed range are disclosed. MPEP 2131.03. In salad dressing embodiments describing compositions containing both fish oil and vegetable oil, Schroeder et al. discloses the ratios of vegetable oil/fish oil as being from 5:1 to 2:1. Col. 6, Lines 3-6. At a minimum, the

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present invention claims compositions having ratios of vegetable oil to fish oil of 9:1 and a maximum of over 50:1. As such, Schroeder et al. fails to disclose a composition having the ratios of vegetable oil to fish oil as claimed by the present invention.

For these reasons, Applicant respectfully asserts that Schroeder et al. fails to anticipate independent claims 1 and 7. For the same reasons, Applicant respectfully asserts that Schroeder et al. also fails to anticipate claims 2, 3, 6, 8, 9, 12 and 13 which depend from claim 1. Applicant respectfully requests the Examiner withdraw said rejection.

Claim Rejections – 35 USC § 103

The Examiner rejected claims 1, 2, 6-8, 12-16 and 19-24 under 35 USC § 103(a) as being unpatentable over U.S. Patent No. 6,010,720 to Derrieu et al., in view of Greenberg et al. As discussed previously, Applicant has amended independent claims 1, 7 and 19 to further define the invention as relating to a viscous carrier protecting an ingestible substance from degradation caused by assorted environmental factors. Applicant submits that the combination of Derrieu et al. and Greenberg et al. under 35 USC § 103(a) is improper and fails to disclose such a viscous carrier used to protect an ingestible substance.

A criteria to establish a *prima facie* case of obviousness is that there must be some suggestion or motivation either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to combine the reference teachings. MPEP 2142-2143. In re Vaech, 947 F.2d 488, 20 USPQ 2d 1438 (Fed. Cir. 1991). Applicant submits that there is no motivation to combine the Derrieu et al. reference with the Greenberg et al. reference. First, Greenberg et al. describes a pet food composition for improving taste while Derrieu et al.

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relates to the oral delivery of chemicals and medicaments. Second, the Derrieu et al. reference and Greenberg et al. reference disclose two distinct forms of delivery. Derrieu et al. discloses a palatable composition in a solid form (see Page 2, Lines 51-52; see claim 1) while Greenberg et al. discloses a clear, liquid composition (see Abstract; see Page 2, lines 58-63; see Page 4, lines 16-22; see claim 1). There is no suggestion within either reference that a combination of the solid form of Derrieu et al. and the liquid form of Greenberg et al. would lead to a stabilized and shelf-stable mixture for use in protecting and delivering ingestible substances. Due to the distinct forms of the references, i.e., a liquid versus a solid, it is not reasonable to infer a person of skill in the art would believe the combination of the references would in fact lead to the formulation of a stabilized and shelf-stable mixture for use in various product mixtures.

Applicant respectfully submits that the Examiner has failed to establish a case for *prima facie* obviousness and requests that the rejection of independent claims 1, 7 and 19 under 35 USC § 103(a) be withdrawn. For the same reasons, Applicant also requests the rejections to dependent claims 2, 6, 8, 12-16 and 20-24 be withdrawn as well.

The Examiner rejected claims 4, 5, 10 and 11 under 35 USC § 103(a) as being unpatentable over Derrieu et al. and Greenberg et al. in view of U.S. Patent No. 4,867,986 to Desai et al. Applicant respectfully traverses said rejections for the reasons previously discussed relative to the improper combinations of Derrieu et al. and Greenberg et al. As such, Applicant respectfully requests the rejections to claims 4, 5, 10 and 11 be withdrawn.

The Examiner rejected claims 17, 18 and 25 under 35 USC § 103(a) as being unpatentable over Derrieu et al. and Greenberg et al. and in view of U.S. Patent No. 4,518,696 to Gehrman et al. Applicant respectfully traverses said rejections. First, the combination of

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Derrieu et al. and Greenberg et al. is improper as previously discussed. Furthermore, the combination of Derrieu et al., Greenberg et al. and Gehrman et al. with these references is improper. To establish a *prima facie* case of obviousness, there must be some suggestion or motivation either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to combine the reference teachings. MPEP 2142-2143. In re Vaeck, 947 F.2d 488, 20 USPQ 2d 1438 (Fed. Cir. 1991). Applicant submits that there is no motivation to combine the Gehrman et al. reference with the Derrieu et al. and Greenberg et al. references.

The Gehrman et al. reference teaches away from the Examiner's suggested combination. In general, a reference may be said to teach away from its combination with a second reference if a person of ordinary skill in the art, upon reading the first reference, would be led in a direction divergent from the path that was taken by the Applicant. In re Gurley, 27 F.3d 551, 31 USPQ 2d 1130 (Fed. Cir. 1994). As stated previously in Applicant's Appeal Brief, the Gehrman reference states that sunflower seed oil is preferably the "only" liquid ingredient of the medium. See Column 2, lines 61-63 of Gehrman. Even more explicitly, the Gehrman reference states that testing the preservation properties of other oils leads to the conclusion that, "...sunflower oil has special properties for maximizing the preservation of Lactobacilli in oil suspension." See Column 5, lines 21-23. Combining Gehrman with Derrieu et al. and Greenberg et al. would nullify the desired invention of Gehrman, i.e., a suspension medium having sunflower oil as its only liquid. It would also be contrary to the teaching of Gehrman which explicitly categorizes sunflower oil, as having special, advantageous preservation properties.

In light of the Gehrman reference, it cannot reasonably be said that a person skilled in the art would infer that combining Gehrman with Derrieu et al. and Greenberg et al. would result in

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the formulation of a stabilized and shelf-stable mixture in light of the special preservation properties of sunflower oil as described by Gehrman. Instead, a person of reasonable skill in the art would avoid combining Gehrman with Derrieu et al. and Greenberg et al for fear of detrimentally effecting the special preservation properties of sunflower oil as described by Gehrman.

The Examiner rejected Applicant's arguments based on an assertion that the motivation to combine flowed from the fact that both references were directed to compositions comprising oil. But this analysis reduces a Graham analysis, as mandated by the Supreme Court, to a triviality and neglects the statutory mandate for an obviousness analysis to be based on "the whole" with respect to the claim and the cited art. See, for example, MPEP 2141.02 AND 35 U.S.C. § 103(a). As summarized by the MPEP 2141.02 in a bold heading - **"PRIOR ART MUST BE CONSIDERED IN ITS ENTIRITY, INCLUDING DISCLOSURES THAT TEACH AWAY FROM THE CLAIMS."** Furthermore, the fact that references can be combined does not render the combination obvious unless the prior art suggests the desirability of the combination. MPEP 2143.01, citing In re Mills, 16 U.S.P.Q. 2d 1430, (Fed. Cir. 1990).

Applicant respectfully submits that the Examiner has failed to establish a case for *prima facie* obviousness and requests that the rejection of claims 17, 18 and 25 under 35 USC § 103(a) be withdrawn.

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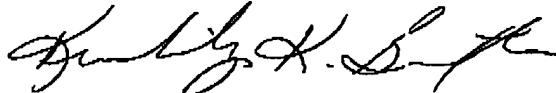
Conclusion

In view of the foregoing, it is submitted that this application is in condition for allowance.

Favorable consideration and prompt allowance of the application are respectfully requested.

The Examiner is invited to telephone the undersigned if the Examiner believes it would be useful to advance prosecution.

Respectfully submitted,



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